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IN THE

Supreme Court of the United States

October Term, 1940

No. 414

BOOTH FISHERIES CORPORATION,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA.**

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THE DISTRICT OF COLUMBIA.**

*To the Honorable, the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your Petitioner, Booth Fisheries Corporation, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia, entered May 13, 1940 (R. 121).

Opinions of the Courts Below.

The United States District Court for the District of Columbia rendered its decision herein without opinion. The Findings of Fact and Conclusions of Law appear in the record at page 112.

The opinion of the United States Court of Appeals for the District of Columbia appears in the record at Page 119, but is presently unreported. A petition for rehearing was denied June 24, 1940, without opinion. (R. 122.)

Jurisdiction.

This is a suit arising under the patent laws of the United States, Judicial Code, Sec. 24 (7), (28 U.S.C.A. 41 (7)). The judgment of the Court of Appeals was entered on May 13, 1940. A petition for rehearing was denied without opinion on June 24, 1940. The jurisdiction of this court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U.S.C.A. 347).

Statutes Involved.

R. S. Sec. 4915 (35 U. S. C. A. 63) authorizing the present suit, and R. S. Sec. 4916 (35 U. S. C. A. 64) providing for reissues are set out in the Appendix.

Summary Statement of the Matters Involved.

In January, 1927, United States Patent No. 1,614,455 (R. 2) was issued to Atlantic Coast Fisheries Corporation as assignee of the inventor, Alexander H. Cooke. The invention of the patent related to the freezing of food products in the shortest possible time ("quick freezing") and in such manner that the refrigerating medium was kept out of contact with the product to be frozen. Briefly, the apparatus described in the drawings and specifications consisted of a vertical series of hollow-walled metal members, each of which was adapted to hold the food product to be frozen. The device was so constructed that each of these members could be raised or lowered in relation to the member immediately above or beneath it. Pressure on the food product held between the adjacent members, was supplied by a weight placed at the top of the series, and the weight of the members and their contents was equalized by appropriate counter-weights. The refrigerating medium

(e.g. cold brine) was introduced into and circulated through the hollow walls of the members. Heat transference was effected by conduction from the food through the metal members between which it was pressed and so to the circulating brine.

It is the position of the Petitioner that in drafting the claims of this patent, Cooke's attorney neglected adequately to claim the invention, new in the art, which was disclosed in the drawings and specifications, to-wit: the method and apparatus for freezing a food product by subjecting it to controlled pressure exerted by the chilled surfaces of freezing members.

In naming and claiming the hollow double-walled metal refrigerating members described and illustrated in the Cooke patent, the term "containers" was used which was possibly not quite as apt as the more specific and equally applicable terms "heat conductive members", "heat conductive plates", "metal plates", "heat conductive surfaces", and the like.

In August of 1930 and in September of 1931, the following patents were issued to Frosted Foods Company, Inc., (R. 20-56) a subsidiary of General Foods Corporation:

<u>Patentee</u>	<u>No. of Patent</u>	<u>Date of Application</u>	<u>Date of Patent</u>
Birdseye	1,773,079	June 18, 1927	Aug. 12, 1930
Birdseye	1,773,081	June 18, 1927	Aug. 12, 1930
Barry	1,822,121	Aug. 12, 1929	Sept. 8, 1931
Birdseye, <i>et al.</i>	1,822,123	July 1, 1929	Sept. 8, 1931

During the pendency of these applications in the Patent Office, the much earlier Cooke patent (applied for on August 20, 1925 and granted January 18, 1927) was never cited (R. 113).

On July 11, 1936, the Petitioner, having prior thereto purchased the Cooke patent from Atlantic Coast Fisheries Company, filed an application for its reissue seeking to correct the inadvertent errors which were made by Cooke's attorney in drafting the claims of the original patent. The application sought to add to the Cooke patent certain claims copied from the Barry and Birdseye patents above described: first, claims (such as Claim 47—R. 14) broadly directed to the use of controlled or predetermined pressure clearly disclosed but unclaimed in the Cooke patent; second, claims directed to details of the apparatus using the hollow-walled containers, and which we submit were of narrower scope than Cooke's original claims since the term "container" includes such terms as "heat conductive plates" for performing the same function as Cooke's containers in acting as supports for the food product to be frozen.

In connection with its application for the reissue patent, the Petitioner introduced evidence (hereinafter more fully discussed) showing that the patentees of the patents from which the added claims were copied, and their assignees, acquired the copied claims through fraud with full knowledge of Cooke's earlier invention derived from Cooke and his associates. These circumstances at least preclude the assertion of the Barry and Birdseye patents as a basis for the application of the equitable doctrine of intervention of private rights.

The Patent Office rejected the application for reissue and the present suit was instituted against the Commissioner of Patents under the provisions of R. S. Sec. 4915 (35 U. S. C. A. 63) in the District Court for the District of Columbia, praying that the Commissioner be authorized to reissue to the Petitioner the Cooke patent, No. 1,614,455. The District Court dismissed the complaint (R. 116).

The Patent Office and the District Court refused the re-issue solely on two grounds: (a) the passage of more than two years between the date of issuance of the original patent and the date upon which the application for reissue was filed; and (b) the supposed failure of the reissue oath to establish inadvertence, accident or mistake in failing to include the added claims in the original patent application. The pleadings in the District Court were similarly limited.

The scope of the disclosure of invention in the Cooke patent was never at any time in controversy either in the Patent Office or in the District Court. There was no contention that the elements of invention included in the added claims had not already been *disclosed* by the original Cooke patent. The controversy had uniformly proceeded upon the entirely correct assumption that if Cooke had applied for a reissue patent within the two-year period, he would have been entitled to it as a matter of course on the basis of the disclosure made in his original patent.

This assumption was not merely an unspoken one. The extent of the Cooke disclosure was specifically considered by the Primary Examiner in the Patent Office, and seven of the new claims were rejected upon the ground that they were not supported by the Cooke disclosure; these seven claims were thereupon cancelled and the matter proceeded upon a consideration of the remaining claims, which not having been rejected on that ground, were conceded to be supported by Cooke's disclosure of his invention (R. 57).

On the appeal to the Court of Appeals for the District of Columbia, two primary issues were presented: first, whether the Petitioner had established that the errors in the original patent which were sought to be corrected in the reissue had arisen through inadvertence, accident or mistake, and second, whether the delay in filing the application constituted a bar to the granting of the reissue patent.

Reasons for Granting Writ.

1. In our summary statement above, we have emphasized the fact that prior to the decision by the Court of Appeals, no contention had been made that the disclosure in the original Cooke patent was inadequate to support the added claims, and that there were presented to the Court of Appeals for decision, only the issues of inadvertence, accident or mistake, and delay in filing the application for reissue. Despite this state of the record, the Court of Appeals in its opinion proceeded to determine the case upon the basis of an issue which was not presented to it, and upon which the Petitioner had been afforded no opportunity to prepare its case. The Court's decision is based squarely and solely on the proposition that the description and disclosure of the Cooke invention did not include and support the subject matter of the added or copied claims. In others words, the Court of Appeals held in effect that even had Cooke included the added claims in his original patent application, they would have been invalid on the ground that they were not supported by his disclosure. We have already pointed out, and will demonstrate more fully in the argument, that not only was this question not in issue, but the Patent Office had conceded the contrary.

The Court of Appeals therefore rendered a decision which is completely at variance with a long line of decisions of this Court, and of other courts of appeal uniformly holding that appellate courts will not consider matters of defense not raised in the trial court. In rendering its decision the Court of Appeals denied the Petitioner due process of law and so far departed from the accepted and usual course of judicial proceeding as to call for the exercise by this Court of its

power of supervision.¹ What appears to be a flagrant disregard by the Court of Appeals of the applicable decisions of this Court, may perhaps be explained by the fact that the Court misapprehended the significance of the issue of inadvertence, accident or mistake, and may have erroneously believed that it was deciding that question. This confusion by the Court of the several issues will be discussed later, but whatever may be the reason for the Court's decision, it calls for review and revision by this Court.

2. The action of the Court of Appeals in deciding the case on the basis of an issue which was not presented to it, left undecided the real questions in the case—questions which present important and substantial problems relating to the interpretation and application of the United States Patent Laws which have not been, but should be, expressly decided by this Court. The record brings into very sharp and well-defined focus a number of serious problems relating to the effect upon an application for reissue of the passage of time between the issuance of the original patent and the filing of the reissue application. This matter of delay has been the subject of a considerable body of opinion in the lower courts, and of equally considerable confusion as to its varying degrees of importance in different situations. This Court, in the recent case of *Crown Cork & Seal Co. v. Gutmann Co.*, 304 U.S. 159 (1938), undertook to clarify some of these problems as they relate to the divisional application cases. It is of the utmost im-

1. This Court has not only held the action of a Court of Appeals in basing its decision on a point not presented or argued by the litigants to be error, but has recognized that such error is ground for granting a writ for certiorari. As recently as January 2, 1940, this Court said, in *LeTulle v. Scofield*, 308 U. S. 415, 416:

“We took this case because the petition for certiorari alleged that the Circuit Court of Appeals had based its decision on a point not presented or argued by the litigants, which the Petitioner had never had an opportunity to meet by the production of evidence.”

portance that a similar clarification be accorded to the reissue cases where a much larger volume of dispute arises.

Questions Presented.

1. Whether a court of appeals may properly decide an appeal upon a ground or defense which was not presented by the pleadings or argument in, or the decision of the lower court.
2. Whether in the absence of fraud or deception, the failure of an inventor, or his attorney, to state his claims in such manner as to cover the entire invention disclosed by him, constitutes inadvertence, accident or mistake within the meaning of the statute relating to reissue patents.
3. In the absence of intervening public or private rights, whether an applicant for a reissue patent is required to show special circumstances excusing a delay of more than two years between the date of issuance of the original patent, and the date of filing the application for reissue.
4. Whether the record in this case establishes special circumstances excusing the delay, if excuse is needed, in the application for reissue of the Cooke patent.
5. Whether regardless of any showing of special circumstances, and regardless of any intervention of public or private rights, the Patent Office is justified in refusing to grant a reissue of a patent having claims *narrower* than those originally included in the patent, on the ground of delay in filing the application.
6. Whether certain of the added claims in the present case are, in fact, narrower than the claims contained in the original patent.

7. Whether delay in applying for a reissue should defeat the right of the applicant where the added claims are copied from issued patents whose patentees had fraudulently acquired the claims on the basis of information obtained from the original assignor of the reissue applicant.

Specification of Errors to be Urged.

The Court of Appeals erred:

1. In deciding that the disclosure in the Cooke patent did not afford an adequate basis for the added claims, this issue not having been presented to the Court of Appeals upon the record.
2. In holding that the record did not establish inadvertence, accident or mistake in the preparation of the original application for letters patent.
3. In failing to hold that the applicant was not required to show special circumstances excusing the delay in applying for the reissue patent; and in failing to find that if such special circumstances were necessary, they were established by the record in this case.
4. In failing to hold that no showing of special circumstances is required to excuse a delay with respect to those claims of the reissue patent which are *narrower* than those contained in the original patent.
5. In failing to find that certain of the added claims were, in fact, narrower than those contained in the original patent.
6. In failing to find that the issued Birdseye and Barry patents containing claims which are the same as the added claims, were fraudulently obtained on the basis of information acquired from Cooke.

ARGUMENT.

I.

The Action of the Court of Appeals in Deciding the Case upon an Issue Not Presented by the Record is Completely at variance with the Settled Decisions of this Court and other Courts of Appeal, and Requires the Exercise by this Court of Its Power of Supervision.

The ground upon which the Court of Appeals sustained the decision of the District Court was the supposed failure of the Cooke patent to "disclose the concept of freezing between two flat refrigerating surfaces", apparently overlooking the fact that no one of the added claims of the reissue application provides for a *flat* plate or surface (R. 11-17). In describing the refrigerating members the claims use such terms as "heat conductive members" (Claims 32, 49), "heat conductive plates" (Claims 34, 46, 51, 54, 55), "metal plates" (Claims 35, 38, 39), "heat conductive surfaces" (Claim 41) although as a matter of fact Cooke's disclosure clearly shows (Fig. 3) that each container has flat surfaces surrounded by side walls for supporting the food products which are engaged on their upper surfaces by the flat lower portions of the next higher container. The Court apparently came to its conclusion for the reason that the drawings and specifications of the specific apparatus described in the Cooke patent as illustrative of his invention show that the members, or "containers" as they are called in the description, had side walls in addition to the flat horizontal surfaces between which the food product is compressed, designed to prevent the lateral escape of the food product.

Had this question been in dispute either in the Patent Office or in the District Court, the Petitioner would have

had an opportunity to demonstrate on the basis of the history of the art and other evidence, that the disclosure of a "container," to-wit: a flat plate equipped with side walls, includes the disclosure of a flat plate whether or not it has side walls. But we have already said that the scope of the Cooke disclosure was not in dispute, and there was no occasion to argue the question or present evidence thereon.¹

The only controversy between the Patent Office and the Petitioner concerning the difference between "containers" and "plates", was concerned solely with the scope of the original *claims* and had no reference to the breadth of the original *disclosure*. It was contended by the Petitioner that the term "container", as used in the claims in the original patent, is a generic term including "plates" as a specific form of container and that when so construed certain of the claims, such as Claims 47, 51 (R. 14-15), containing other limitations, were narrower than the original claims, such as Claims 1 and 16 of the Cooke patent (R. 79). Thus the reissue application was, to this extent at least, outside any rule of laches. The Patent Office in effect denied that the term "plates" was included in the

1. As an example of the type of material that would have been included in the record had the question been raised in the District Court, applicant's amendment cancelling certain of the claims stated specifically that the reason for the cancellation was to avoid complicating the issue by a discussion of the Cooke disclosure.

Although no effort was made to produce evidence upon this undisputed point, it should be noted that the Petitioner did produce evidence on another point which has a bearing upon the scope of the Cooke disclosure. James J. Barry and Harden F. Taylor testified with respect to the scope of the original claims. Mr. Barry, the patentee of Patent No. 1,822,121 (one of the patents from which Claims 47-49, 51-57, and 59 were copied) testified (R. 99) that a flat plate was included within the term "container" so that the element of flat plates was, in his conception, not only within the disclosure of the Cooke patent, but also within the scope of its claims. Mr. Taylor, an authority on the entire art, similarly testified (R. 94): "The first I ever heard of the freezing of food products, particularly fish, between refrigerated plates under pressure, was the suggestion from Mr. Cooke." The only evidence in the record, therefore, bearing upon the issue raised by the Court of Appeals is directly contrary to the Court's conclusion.

meaning of "containers", but again this had reference only to the scope of the claims. We do not intend to labor the point unduly, but it is essential that it be borne in mind that the scope, or extent, to which an invention is claimed in a patent, is separate and distinct from the extent to which it may be disclosed by the apparatus and specifications shown in the application.

The decision of the Board of Appeals (R. 64), did not, any more than that of the Patent Office, make any reference to the scope of the Cooke *disclosure*, although the opinion on rehearing (R. 66) did consider the scope of the original Cooke *claims*.

The answer of the Commissioner of Patents to the Bill of Complaint in the District Court, made no defense on the ground that the disclosure of the Cooke patent did not support the added claims, but relied entirely upon the defense that the record did not establish inadvertence, accident or mistake, and that the plaintiff was not entitled to relief "for the reasons stated in the statement of the Examiner in answer to the appeal, and the decision of the Board of Appeals". (R. 74) The District Court in its findings of fact (R. 112) and conclusions of law (R. 114) similarly made no mention of the adequacy of the Cooke disclosure.

Enough has been said to demonstrate, we believe, that no issue with respect to the adequacy of the Cooke disclosure was before the Court of Appeals.

Nothing is more firmly settled than the rule that a cause or theory of action or defense may not be raised for the first time in a reviewing court. This rule is no more than an application of ordinary common sense. It proceeds upon the principle that the reviewing court should confine its ruling to matters presented by the record, and it protects the right of the parties to limit their preparation of

the case to the problems which have been raised by the pleadings. This Court has had occasion in a great number of instances to state this principle as an elementary rule of conduct in the administration of justice. *General Utilities, etc. Co. v. Helvering*, 296 U. S. 200; *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 35; *Casey v. U. S.*, 276 U. S. 413, 418; *Van Huffel v. Harkelrode*, 284 U. S. 225, 229.¹

The predicament of the Petitioner is best described in *West Ohio Gas Co. v. Pub. Util. Comm'n (No. 1)*, 294 U. S. 63, 69, where the Court said that the raising of a new point deprived the other party of the right to present evidence, and was violative of the Fourteenth Amendment. That is the situation in this case. The Petitioner, not being advised that any question would be raised with respect to the scope of the Cooke disclosure, did not present evidence thereon, and no evidence was presented by the Commissioner. The holding of the Court of Appeals on that question is therefore based on no evidence, and has no record to support it.

The Court of Appeals having arrived at the erroneous, and (on the record) irrelevant, conclusion that the Cooke disclosure failed to include the concept of freezing between flat plates (although *flat* plates are not mentioned in any of the added claims), proceeded to hold that this failure was "so plain as almost to compel the inference that it was not due to inadvertence, accident or mistake. Accordingly the District Court's finding to that effect is fully supported by the evidence". It is true that the District Court had entered a conclusion of law (R. 114) to the effect that there had been no inadvertence, accident or mis-

1. Literally scores of other cases might be cited for the same proposition, including the following:

United Railways & E. Co. v. West, 280 U. S. 234, 248;

Blair v. Oesterlein Machine Co., 275 U. S. 220, 225;

United States v. La Franca, 282 U. S. 568, 576; *Burnet v. Commonwealth Improvement Co.*, 287 U. S. 415, 418.

take, but its conclusion was entirely unsupported by any finding of fact, and was in utter disregard of the uncontradicted reissue oath. The Commissioner had not denied the truth of the reissue oath, but had denied its adequacy as a matter of law. (R. 74.)

The question which the Court of Appeals was called upon to decide, but failed to consider, was whether the reissue oath established, as a matter of fact, inadvertence, accident or mistake. The Amended Oath No. 2 (R. 61) sets forth that at the time of making his application for the patent, Cooke was unskilled in the art of preparing claims and was unaware of the fact that the claims as drawn by his attorney failed to provide as broad a protection as his invention warranted. The oath states further that the failure to claim the invention more broadly was due to the mistake of Cooke's attorney, and that this failure was without any fraudulent or deceptive intention. These statements of fact were, by the pleading, admitted to be true.

In the absence of any evidence to the contrary, the facts set forth in the amended oath were sufficient to establish inadvertence, accident or mistake, and the Court of Appeals should have so held. *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, (C. C. A. 6th, 1921), 276 Fed. 234, 238; *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, (C. C. A. 9th, 1920), 266 Fed. 698, cert. denied, 254 U. S. 652; *Toledo Computing Scale Co. v. Moneyweight Scale Co.*, (C. C. N. D. Ill. 1910), 178 Fed. 557, aff'd. 187 Fed. 826; *Crown Cork & Seal Co. of Baltimore City v. Aluminum Stopper Co. of Baltimore City*, (C. C. A. 4th, 1901), 108 Fed. 845.¹

1. "Mistake or inadvertence making a patent inoperative or invalid may be that of the patentee or his solicitor, either in preparing the specification or claims. If the solicitor fails to understand and properly describe or claim the real invention, by making claims so broad as to be anticipated, or so narrow as to be inoperative, this is such mistake as to authorize a reissue, if

The statement of the Court of Appeals that the "failure of the application to disclose the concept of freezing between two flat refrigerating surfaces is so plain as to compel the inference that it was not due to inadvertence, accident or mistake", is a *non-sequitur*. It is of course true that if the scope of the disclosure was not sufficient to support the added claims which the Petitioner asked to be included in the reissue patent, the application for reissue must fall on that point alone.

If there was no error—no failure to make the claims co-extensive with the invention—there would be no occasion to inquire whether the error arose through inadvertence, accident or mistake.

We submit, therefore, that although the Court of Appeals purported to decide that there was no inadvertence, accident or mistake, its decision rests upon the determination of a collateral issue—one which it had no right to decide upon the basis of the record presented to it.

II.

The Record in this Case Presents, and the Court of Appeals left Undecided, Questions Involving Substantial Problems requiring Decision and Clarification by this Court.

**The Delay of More Than Two Years
in Applying for the Reissue Patent.**

The original Cooke patent was issued on January 18, 1927, and the application for reissue was not filed until

authorized on other grounds." (*Toledo Computing Scale Co. v. Moneyweight Scale Co.*, (C. C. N. D. Ill. 1910), 178 Fed. 557, 559; *aff'd*, 187 Fed. 826).

"* * * A review of the earlier decisions of the Supreme Court would seem to show that by 'defective or insufficient specifications' was meant any failure either to describe or claim the complete invention upon which the application for the patent was founded, and that 'inadvertence or mistake' was used in antithesis to fraudulent intent, and that the right to reissue depends upon any failure to make specifications and claims legally adequate to their purpose, if due to any cause except an intention to deceive." (*Crown Cork & Seal Co. of Baltimore City v. Aluminum Stopper Co. of Baltimore City*, (C. C. A. 4th, 1901), 108 Fed. 845.)

July 11, 1936. The Commissioner of Patents relied upon this delay in rejecting the application.

It will be noted that the statute under which the reissue was sought, does not itself impose any limitation of time within which the application must be filed. The Supreme Court, however, in 1882, in the case of *Miller v. Brass Company*, 104 U. S. 350, laid down the rule that reissue patents with broadened claims ought not to be granted if there was an unreasonable delay in filing the application. In *Mahn v. Harwood*, 112 U. S. 354, the Supreme Court again said that an applicant for a reissue patent was held to reasonable diligence and, by analogy to the rule as to the effect of public use before an application for a patent, a delay of more than two years would in general require special circumstances for its excuse.

An analysis of the decisions following *Mahn v. Harwood* shows that the rationale of the two-year limitation is the assumed intervention, after the grant of the original patent, of public or private rights. The limitation was taken over by the Court from the statutory two-year period for public use, the theory being that when a device has been in public use, the public has a right to assume that the producer has abandoned any patentable protection thereon, and from that point on the rights of the public intervene. It was said in *Mahn v. Harwood*:

“But there are substantial reasons not applicable to these cases [narrowed reissues] why a claim cannot be enlarged and made broader after an undue lapse of time. *The rights of the public here intervene* which are totally inconsistent with such tardy reissues.”

After pointing out that the claim of a patent operates as a disclaimer as to what is not covered thereby the Court said:

"The public has the undoubted right to use and it is to be presumed does use what is not specifically claimed in the patent. Every day that passes, after the issue of the patent, adds to the strength of this right and increases the barrier against subsequent *expansion* of the claims by a reissue under a pretense of inadvertence and mistake."

The Court then went on to say:

"As before stated, the case is entirely different from that of a reissue by reason of a defective specification or description, or on account of the claim being too broad. In these cases, the *public interest* is promoted by the change."

(The italics in each of the above quotations are ours.)

In *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U. S. 463, 466, the Supreme Court, in considering the subject of delay in applying for reissues, said, "but it is no less important that the law should not be so loosely construed and enforced as to subvert its limitations and bring about an undue extension of the patent monopoly against private and public rights."

It is clear, then, that the basis for limiting the time within which the application for reissue may be filed is that delay may prejudice the public by withdrawing from the public domain the subject matter of the claims which are added to the original patent, or that it may prejudice private rights which may have intervened after the grant of the original patent. Where no public or private rights have intervened, the delay should require no excuse and no showing of special circumstances.

This Court, in the recent case of *Crown Cork & Seal Co. v. Gutmann Co.*, 304 U. S. 159 (1938), rendered a final and explicit decision on the need for showing special circumstances to excuse delay, in the absence of intervening rights, as applied to divisional applications. Although the analogy between such cases, and cases of applications for reissue,

is quite clear and persuasive, it is important that this Court remove any possible ambiguity by applying the same rule to the reissue cases.

The *Crown Cork & Seal Co.* case involved an interpretation of this Court's earlier opinion in *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U. S. 463. The specific question presented by the petition for certiorari as stated by the Court at page 160 of its opinion, is as follows:

"Does this Court's decision in *Webster Co. v. Splitdorf Co.* (264 U. S. 463) mean that, even in the absence of intervening adverse rights, an excuse must be shown for a lapse of more than two years in presenting claims in a divisional application regularly filed and prosecuted in accordance with patent office rules?"

It appeared that the applicant had filed his divisional application more than two years after the date of the original patent. In spite of this fact the Court made the following specific ruling based upon an analysis of the *Webster* case (at page 167):

"It is clear that in the absence of intervening adverse rights, the decision in *Webster Co. v. Splitdorf Co.* does not mean that an excuse must be shown for a lapse of more than two years in presenting the divisional application."

This rule should be applied with equal force to the reissue cases. In fact the doctrine in the *Splitdorf* case itself is derived from and is based on a recognized analogy between the divisional and reissue cases. The Court there said, "While the analogy between the case of a reissue patent and that of copying for interference is not always an exact one, it is sufficiently so as applied to the present case to make these decisions pertinent; and the principle which they announce is controlling." (264 U. S. at page 469.)

If no special circumstances are required to excuse delay, in the absence of intervening rights, so far as divisional

applications are concerned, the same principle ought to follow *a fortiori* in the reissue cases. The term of a patent acquired on a divisional application runs from the date of its issuance, thereby permitting the inventor to prolong the period of his monopoly. In a reissue case, on the other hand, the term of the reissue patent runs from the date of the original patent and involves no extension of the monopoly period. Mr. Justice Black dissented from the decision in *Crown Cork & Seal Co. v. Gutmann Co.*, on the ground that the Court's decision might afford a procedural device, through divisional applications, by which the patent monopoly might be extended beyond the statutory limit of seventeen years, but pointed out, (at page 172 of the opinion) that this danger did not apply to reissue applications for the reason that reissue patents ran only for the unexpired portion of the seventeen-year patent grant.

There is every reason, therefore, why the Supreme Court should apply to the reissue cases the same doctrine which it applied in *Crown Cork & Seal Co. v. Gutmann Co.* to divisional applications: that no excuse need be shown for a delay of more than two years where there have been no intervening adverse rights.

It is the contention of the Petitioner that the application of this rule to the instant case would result in a holding that no special circumstances need be shown by the Petitioner to excuse the delay of more than two years in applying for the reissue patent because, as will be seen from the discussion below, there are no properly founded intervening adverse rights which can be asserted against the Petitioner.

No Public or Private Rights Have Intervened.

The intervention of public rights means nothing more than the right of the public to receive, free from patent

monopoly, the benefit of disclosures made but unclaimed in issued patents. In other words, the theory is that once an invention, save as specifically defined in narrow claims, has come into the public domain it ought not to be withdrawn therefrom to the prejudice of the public, by including broader claims for the invention in a reissue patent. We have no quarrel with this theory as such, but it has no application to the present case. So far as the public is concerned, the subject matter of the added claims has never been in the public domain, and the public has acquired no rights thereunder in view of the fact that a *prima facie* monopoly with respect to this subject matter exists under the Birdseye and Barry patents.

In the lower Court the respondent relied heavily upon *Hartshorn v. Saginaw Barrel Company*, 119 U. S. 664, and particularly the statements on pages 674 and 675, in support of its position that the inclusion in the issued Birdseye and Barry patents, is immaterial to the question of public intervening rights.

In the *Hartshorn* case, the Circuit Court of Massachusetts (18 Fed. 90) had sustained a reissue patent against the defense of alleged public intervening rights on the ground that the claim of a reissue patent to Campbell had been copied from a patent to Hartshorn, so that at no time was the invention open to the public.

As stated in the decision of the Circuit Court (Judges Lowell and Nelson), it was held (page 92):

“ . . . The defendants argue that if we look at the Campbell patent alone, he would seem to have neglected for 10 years to enlarge his claim. This is true; but the public were not injured, for the same claim was found in the patent of Hartshorn. The invention was not thrown open to the public,—was not abandoned.”

When the case reached this Court, it was held that the reissue patent was invalid, it being pointed out that Harts-

horn through an honest mistake had made a false claim "to which he now confesses he was not entitled, and for that reason his original patent was invalid". (119 U. S. 674)

After the facts were known, of course Hartshorn was in no position to assert his patent against the public.

In the present case, the situation is quite different. There is no confession by the owners of the Birdseye and Barry patents that these are invalid, so that merely on the basis of their *prima facie* validity they can be (and in fact have been) asserted against the public, and the public is not free to use the inventions covered by the claims without liability to litigation. There has thus been no abandonment to the public of the claimed inventions.

In the present case, if the prayer of the Bill should be granted authorizing the Commissioner of Patents to grant the Birdseye and Barry claims in a reissue of the Cooke patent, there would of course be an interference in the Patent Office to settle all questions of actual priority of invention as between Cooke on the one hand and Birdseye and Barry on the other. Thus full opportunity would be given to the latter to establish priority if they could, but failing this, the reissue patent would be issued with the contested claims therein. The public would thus have the advantage of knowing that Cooke had in fact proved himself to be the prior inventor, so that the Birdseye and Barry claims could be disregarded. Far from abrogating the rights of the public, the public would have the advantage of a shortening of the period of monopoly on account of the expiration of the Cooke reissue patent between three and one-half and four and one-half years earlier than the expiration of the Birdseye and Barry patents.

The question here involved is believed to be one of fundamental importance, and if the decision of this Court in the *Hartshorn* case can be interpreted to have any appli-

cation beyond the actual state of facts there involved, we submit that any such implication should be denied by this Court, particularly in view of the recent decision in *Crown Cork & Seal Co. v. Gutmann Co.*, 304 U. S. 159, which we have already discussed.

The only possible private intervening rights which might be asserted are those which would have been gained by the owners of the Birdseye and Barry patents were it not for the fact that their "rights", if any, were fraudulently acquired after notice of the Cooke disclosure. These patentees and their successors are not entitled to protection for two reasons: first, because the Cooke patent was granted several years before the applications for the Barry and Birdseye patents were filed, and the patentees were, therefore, on notice that the claims granted to them through the oversight of the Patent Office were void for lack of invention; and second, because such patentees are without standing in a court of equity, in view of the prima facie showing, contained in the record, that they had fraudulently acquired the patent claims in question by falsely claiming to have invented the subject matter which they had, in fact, acquired from Cooke.

We cannot undertake here to analyze the record upon this subject in any detail. It will suffice for the purposes of this Petition to summarize briefly the evidence given by Cooke, Barry and Dr. Harden F. Taylor.

Dr. Taylor was, from 1918 to 1922, Chief Technologist in the U. S. Bureau of Fisheries, and during that period was intensely occupied in the study of the quick freezing of fish, having made a number of experiments with the early Otteson machine obtained from Denmark (R. 91). In the fall of 1923 he was approached by Clarence Birdseye, who was attempting to merchandise fish in insulated packages and was having trouble (R. 93). In response to Mr. Birds-

eye's request Dr. Taylor called on him in New York and disclosed to him the idea of quick freezing, this being the first knowledge thereof that Birdseye had received (R. 93). Shortly thereafter, in the latter part of 1923, Dr. Taylor became an officer of Atlantic Coast Fisheries Company, and through Mr. Cooke, the patentee of the patent here involved, began development work toward the quick freezing of fish (R. 93).

James J. Barry, the patentee of Patent No. 1,822,121 from which certain of the added claims were adopted, was also employed by Atlantic Coast Fisheries Company, and left its employ to associate himself with Clarence Birdseye (R. 95). During this employment and subsequent thereto, by reason of friendly contacts with Mr. Cooke, Dr. Barry was fully advised of all the proposed developments in quick freezing which had been suggested by Dr. Taylor and Cooke, and these he communicated to Mr. Birdseye (R. 95, 99).

In his testimony, Dr. Barry admitted that the claims copied from his patent and forming a part of those sought to be added by the reissue, were not invented by him, but were invented by Mr. Cooke (R. 98); that the application for the said Barry patent, No. 1,822,121, was signed by him several years after leaving the employ of the successor to Mr. Birdseye's company (R. 96); the said application was filed August 12, 1929, nearly four years after Barry had seen the Cooke machine. The evidence further shows (R. 99) that Birdseye had every opportunity to be equally well informed concerning the Cooke machine, the issuance of the Cooke patent, and the issuance of the Bureau of Fisheries Booklet No. 1016, in which the Cooke machine is illustrated and described.

Cooke, himself, testified (R. 88) that he discussed developments freely with Dr. Barry, this intimacy continuing after Barry resigned and became associated with Birdseye.

This testimony clearly establishes a *prima facie* case, uncontradicted in the record, that Birdseye and Barry fraudulently obtained the broad claims involved herein on the basis of information acquired from Cooke. On this subject the District Court made no finding of fact except a finding (R. 115) that:

“The contention of plaintiff and the testimony of James J. Barry regarding alleged lack of knowledge by Barry as to the disclosure and claims of his application, on which Patent No. 1,822,121 issued, is refuted by Barry’s execution of the application papers and the supplemental oath filed during the prosecution of said application.”

This finding by the Court implies a much greater degree of fraud than was disclosed by the testimony of Barry, since it holds in effect that Barry executed his application with the full knowledge that the claims contained therein would prohibit the use of Cooke’s machine although, as he well knew, Cooke was the original inventor of the subject matter of the claims. We impute no such deliberate fraud to Barry who was unversed in the precise meaning and effect of patent claims. The fraud was rather that of the owners of the Barry patent who apparently induced him to sign papers the real import of which were not made clear to him.

The Doctrine of Intervening Rights Should Not Be Applied to Reissues With Narrowed Claims.

We have argued that the reason for the rule requiring the showing of special circumstances to excuse a delay of more than two years, is the possibility that laches in applying for the reissue may operate to the prejudice of intervening public or private rights. We have demonstrated that there are no intervening public or private rights in this case. This is especially true with respect to those claims in the reissue patent which are narrower than

the claims in the original patent, because as a matter of law, no public or private rights could possibly intervene. A reissue with narrowed claims takes nothing from the public, or any individual, since the subject matter thereof is included within the original broad claims.

In the case of *Mahn v. Harwood*, 112 U.S. 354, this Court recognized the distinction between broadened and narrowed claims when it said, "lapse of time may be of small consequence on an application for the reissue of a patent on account of a defective specification or description, or where the original claim is too broad." (P. 360.)

At page 362 of the opinion, the Court said, "As before stated, the case is entirely different from that of a reissue by reason of a defective specification or description, or on account of the claim being too broad. In these cases the public interest is promoted by the change."

The Second Circuit Court of Appeals in *Specialty Machine Co. v. Ashcroft Manufacturing Co.*, 213 Fed. 35, has stated the rule with respect to the delay in applications for a reissue with narrowed claims, as follows:

"As to reissue. The original claims will be found in the opinion below. It seems to us that the change effected by reissue was not a broadening of the claims, but a narrowing of them, and that, therefore, the reissue more than two years after the granting of the original patent was proper * * *." (P. 40.)

The same principal has been applied in two recent District Court cases. In *General Electric Co. v. Munder Electrical Co.*, 22 Fed. Supp. 291 (D.C. Mass. 1938) the Court said (P. 296):

"It is further contended by the defendants that in the present case rights of the defendants intervened prior to the reissue. As to this contention it is sufficient to say that, since the added claims are narrowed and not broadened, the doctrine of intervening rights

is inapplicable. 'Intervening rights can be acquired only in connection with a broadened reissue; the doctrine is not applicable to a narrowed reissue.' Walker on Patents, Dellar Ed. 1937, p. 1373, 6th Ed. pp. 373, 374."

In the District Court opinion in *Crown Cork & Seal Co. v. Gutmann Co.*, 14 Fed. Supp. 255, the Court summed up the general rule and the authorities as follows (P. 268):

"Defendant infringed claim 1, carried over from the original patent, and since the reissue was filed to obtain more limited claims, acquired no intervening rights. *Abercrombie & Fitch Co. et al. v. Baldwin et al.*, 245 U.S. 198, 38 S. Ct. 104, 62 L. Ed. 240; *Babcock & Wilcox Co. v. Springfield Boiler Co. et al.*, (C.C.A.) 16 F. (2d) 964; *Ball & Roller Bearing Co. v. F. C. Sanford Mfg. Co.* (C.C.A.) 297 F. 163; *Maitland v. Goetz Mfg. Co.* (C.C.A.) 86 F. 124; *Vortez Mfg. Co. et al. v. F. N. Burt Co., Limited* (D.C.) 297 F. 513; *Hawie Mfg. Co. v. Hatheway Mfg. Co. et al.* (D.C.) 27 F. (2d) 937; *Steiner & Voegtly Hardware Co. v. Tabor Sash Co.* (C.C.) 178 F. 831."

The authorities clearly support the proposition that no public or private rights can be said to have intervened where the reissue patent is sought with narrowed claims.

The contention of the Petitioner that certain of the added claims in the reissue patent (specifically Claims 46, 47, 48, 49 and 51, appearing at R. 14 and 15) are narrower than the claims of the original Cooke patent, is predicated upon the proposition that the word "container," as applied to the members adapted to hold and press between them the product to be frozen, includes within its meaning the type of receptacle described in the added claims as "heat conductive plates," "supporting plates," or "heat conductive members." It should be remembered that the "containers" as described in the drawings of the Cooke patent (Fig. 3, R. 4), have side walls to prevent the lateral escape of the food product. The "plates" mentioned in the Barry

patent No. 1,822,121 (R. 45) and the Birdseye et al. patent No. 1,822,123 (R. 52) from which the above-enumerated claims are derived, are shown in the drawings of said patents to be exactly the same as the "containers" of the Cooke patent with the single exception that the side walls are removed.

Obviously, the word "container" as used in the claims of the Cooke patent must be given a meaning which corresponds with the inherent function of the device disclosed and with the nature of the food product to be placed thereon. The word "container" as a noun has a multitude of meanings, each peculiar to the character or nature of the material or substance that is being handled or stored; for example, when speaking of a container for fresh milk, one has a mental picture of a milk bottle; a container for breakfast food brings to mind a pasteboard box; a glass bowl may be said to be a container for sugar; a book case may be a container for books; a layer cake may be said to be contained on a shallow plate. Other uses of the word involve its association with compounds, such as salt or sugar, which are said to contain a certain percentage of water; the atmosphere containing oxygen and nitrogen, etc.

In other words, "container" is a broad term that receives its true meaning only by reference to the character of the material that is to be "contained." If a liquid or semi-liquid substance is in contemplation, it is obvious that provision must be made for restraining the material from escaping, although this is not completely true in the case of a griddle on which griddle cakes are fried. The griddle may properly be said to be a container for the semi-fluid batter that is poured thereon and yet there are no side or lateral walls for restraining the batter.

In the case of the Cooke patent, if a liquid had been in contemplation, it would unquestionably call for a con-

struction of the term "container" such as that shown in the drawings; that is, a concave receptacle, the floor of which is bounded by four side walls. However, it should be borne in mind that Cooke discussed an apparatus particularly intended for the refrigeration of food and food products, fish being only one of many of such products that might be treated. It is readily apparent, therefore, that while some of the food products would require no side walls, such products being in the form of solids, (e. g. a piece of steak) others thereof that he may have had in mind were of liquid and semi-liquid form. The apparatus, therefore, was constructed to adapt itself to the freezing of all forms of food products, either liquid or solid. When freezing solid products, the side walls had no function, the floor of one section and the bottom of an upper section, acting as a cover, constituting two hollow, flat plates, the food product being adapted to be contained and held under pressure between the plates.

That Cooke himself obviously assumed that the word "container" included a flat plate, with or without side walls is evidenced by his original drawing of his first machine introduced as "Exhibit 1" (R. 77), in which flat plates without side walls were actually used. Later on, he provided the side walls, not as a function of the freezing device, but for the purpose of preventing the escape of the slippery fish, the product handled by the company with which he was associated.

The evidence in the record relating to the meaning of the word "container" is uncontradicted. In his deposition (R. 87), Mr. Cooke stated the meaning of the term as follows:

"My understanding of the word 'containers' as used in the claims of my patent No. 1,614,455 is, broadly, anything to contain the article to be frozen. If I were freezing packaged fish, there would be no advantage in using plates having depressions therein. At

that time, we did not believe in enclosing an article to be frozen in an insulating medium such as a carton. To freeze unpackaged fillets, it is necessary to provide means to prevent lateral spreading of the block of fillets, and the side walls of the device of my patent took the place of the walls of a carton. The construction of the plates with depressions therefor broadened the commercial use of the device."

In Dr. Harden F. Taylor's deposition (R. 94), the statement is made that "plates" are included within the Cooke invention, as follows:

"The first I ever heard of the freezing of food products, particularly fish, between refrigerated plates under pressure, was the suggestion from Mr. Cooke."

James J. Barry, the patentee of patent No. 1,822,121, confirmed these statements as follows (R. 99):

"My understanding of the word 'container,' as used in the Cooke patent, is that it is intended to cover anything adapted to contain the material to be frozen, and that if packaged fillets are to be frozen, a container might be a flat plate, the sides of the package acting to retain the fish laterally, the pressure being used only that necessary to exclude air from the body of the package and the fillets. If two flat plates were used for confining between them a relatively solid non-flowing product, I would consider that the lower plate was a container in the sense of the patent. If, in such a machine, a relatively flowing product is confined within a carton and placed between said plates, I would consider that the lower plate, in conjunction with the carton walls, was a container in the sense of the patent."

The above statements establish what seems a perfectly obvious fact that the term "container" as used in the Cooke patent was intended to mean a mechanical device that would support the food product, the upper and lower surfaces of which were pressed between the chilled surfaces

of adjacent "containers" during the freezing process, and that a "flat plate" without side walls or a "flat plate" with temporary side walls, such as provided by a frame or cardboard box (R. 29; line 121, *et seq.*) if it performs this essential function, is a "container" in the exact sense called for by the claims.

Special Circumstances Justifying Delay.

Upon the Petitioner's theory that there are no intervening public or private rights which may be asserted against the Cooke reissue, and especially so with respect to those claims of the reissue application which are narrower than the claims of the original patent, it is unnecessary to show any special circumstances justifying the delay of more than two years in applying for the reissue. Nevertheless, even if the Court should come to the conclusion that special circumstances are required, it is our contention that such circumstances have been sufficiently established by the record in this case. Cooke as the inventor and as Vice President of Atlantic Coast Fisheries Corporation, the first assignee of the patent, stated in his oath (R. 61) that he did not know of the shortcomings in his patent until approximately thirty days before executing the oath.

The President of Atlantic Coast Fisheries Corporation, Harden F. Taylor, testified (R. 94) that he did not know of the conflict between the Birdseye and the Cooke patents, and that if the matter had come to his attention he would presumably have taken steps to obtain a reissue of the Cooke patent. It must be borne in mind that laymen do not understand or appreciate the importance of claims as defining the monopoly granted in a patent. They look at *structures* and draw their conclusions from comparisons of structures. Harden Taylor and Cooke knew of the Birdseye and Barry structures; knew that they were different in detail from the Cooke structure; knew that Cooke was sev-

eral years earlier in point of time than Birdseye, and knew that Barry and indirectly Birdseye, had full knowledge of the Cooke designs for several years before the filing of the applications for their patents. It never occurred to them, nor would it have occurred to any other layman that Birdseye and Barry would or could secure the allowance of claims in their applications that would dominate and actually prevent the use of the Cooke structure. While the law charges the individual with constructive notice of the issuance of a patent and with consequent knowledge of the scope of the claims of the patent, this notice and knowledge can, as in this case, be offset by a showing of actual facts to the contrary.

CONCLUSION.

The decision of the Court of Appeals rests upon its determination of an issue not presented by the record, and leaves undecided the real questions in the case. Were it not for this fact the Court of Appeals should have decided (a) that the errors in the original patent sought to be corrected by the reissue arose through inadvertence, accident, or mistake; (b) that although there was a delay of more than two years in applying for the reissue patent, there were no intervening public or private rights which required special circumstances to excuse the delay; (c) that at least with respect to the narrowed claims in the reissue patent no public or private rights could have intervened as a matter of law; (d) that even if special circumstances were required to excuse the delay, such circumstances had been established by the Petitioner.

Not only is the error of the Court of Appeals so serious as to require the exercise by this Court of its power of supervision, but it left undecided problems so important to the entire field of reissue applications as to require clarification by this Court.

It is respectfully submitted, therefore, that the Petition for a Writ of Certiorari to review the judgment of the United States Court of Appeals for the District of Columbia, should be granted.

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